

**EXHIBIT 5  
TO  
DEFENDANTS' OPPOSITION TO PLAINTIFF'S MOTION  
TO EXCLUDE THE TESTIMONY OF  
RANY SIMMS**

UNITED STATES DISTRICT COURT  
FOR THE WESTERN DISTRICT OF VIRGINIA  
Charlottesville Division

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CFA INSTITUTE

Plaintiff

v.

AMERICAN SOCIETY OF PENSION:  
PROFESSIONALS & ACTUARIES;

AMERICAN SOCIETY OF PENSION: Civil Action No.  
PROFESSIONALS & ACTUARIES, : 3:19-cv-00012

D/B/A NATIONAL ASSOCIATION :  
OF PLAN ADVISORS; and :

AMERICAN SOCIETY OF PENSION:  
PROFESSIONALS & ACTUARIES, :

D/B/A AMERICAN RETIREMENT :  
ASSOCIATION :

Defendants

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Friday, May 1, 2020

Video deposition of RANY SIMMS,  
taken virtually via Zoom, with the witness  
participating from his home address in  
Fairfax Station, Virginia, beginning at 10:02  
a.m., before Ryan K. Black, a Registered  
Professional Reporter, Certified Livenote  
Reporter and Notary Public in and for  
the Commonwealth of Pennsylvania.

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I N D E X

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By Mr. Kilaru.....	97

E X H I B I T S

EXHIBIT	DESCRIPTION	MARKED
Plaintiff's 1	Mr. Simms' expert report	21
Plaintiff's 2	TSDR printout for logo mark, Application Serial Number 87103390	37
Plaintiff's 3	Drawing for Logo Mark, U.S. App. Serial No. 87103390	37
Plaintiff's 4	CFE Certificate of Reg. No. 1714241	49
Plaintiff's 5	CFX Certificate of Reg. No. 2639605	49
Plaintiff's 6	CDFA Certificate of Reg. No. 4771896	49
Plaintiff's 7	CSFP Certificate of Reg. No. 3069136	49
Plaintiff's 8	Document pertaining to the CFL mark	59

I N D E X (Cont'd)

EXHIBIT	DESCRIPTION	MARKED
Plaintiff's 9	CTP Certified Treasury Professional & Design Certificate of Reg. No. 3016770	61
Plaintiff's 10	CNC Certified Nonprofit Consultant & Design Certificate of Reg. No. 4067860	62
Plaintiff's 11	CFSP Chartered Senior Financial Planner Certificate of Reg. No. 3069136	64
Plaintiff's 12	CFL Certified Financially Literate & Design Certificate Reg. No. 3970928	68
Plaintiff's 13	CTP Certified Treasury Professional & Design Certificate of Reg. No. 3016770	68
Plaintiff's 14	CFA Institute Certificate of Reg. No. 4389314	69
Plaintiff's 15	CFA Institute Certificate of Reg. No. 4768863	69

(Exhibits attached to transcript.)

1 plaintiff, things of that nature.

2 I don't know if I opined, and  
3 I probably did not, about the strength or  
4 weakness of plaintiff's mark, but, certainly,  
5 the implication is there with the listing of  
6 numerous third-party registrations.

7 Q. So can you point me to an opinion in  
8 your report that you plan to offer at trial?

9 MR. KILARU: I'd object. That  
10 document speaks for itself.

11 MR. NADING: Actually, it does not.  
12 BY MR. NADING:

13 Q. Can you point me to a -- a statement  
14 in your report, where -- where your opinions are  
15 in your report.

16 A. Well, let me quickly review it.

17 Q. Take as much time as you need.

18 A. Well, I think in answer to your  
19 question, I would say that it's the significance  
20 of what I have done in this report as far as the  
21 -- the trial -- trier of fact may look at it,  
22 as far as the -- what happened in the history  
23 of this case, the fact that the -- there are  
24 numerous third-party registrations. And I  
25 had mentioned the DuPont case, the -- the fact

1           that third-party registrations are -- have  
2           a bearing on the strength or weakness of  
3           plaintiff's mark, the fact that the -- the  
4           various -- which I mentioned, various  
5           third-party registrations issued without any  
6           refusals by examining attorneys, I think these  
7           are all facts which the trier of fact may want  
8           to have before him or her in deciding the  
9           ultimate issue in this case.

10                   As far as offering an opinion that  
11           says, oh, plaintiff's mark is weak because there  
12           are a number of third-party registrations here,  
13           there are a plethora of them, I never came  
14           outright and stated that, but I did certainly  
15           make that implication by listing page after page  
16           of third-party registrations for related goods  
17           and services in the financial servicing  
18           industry.

19                   Q.    So there are -- there are,  
20           potentially, additional opinions that you plan  
21           to offer that aren't contained in your report.  
22           Is that what you're saying?

23                   MR. KILARU:  Objection.

24           Mischaracterizes prior testimony.

25           BY MR. NADING:

1 Q. Is that what you're saying?

2 A. If called upon to go beyond what I  
3 stated, I would do so at trial, yes. The  
4 implications are there. I mean, why else would  
5 I list page after page of third-party  
6 registrations unless it has some bearing upon  
7 this case.

8 Q. With all due respect, you've been  
9 tendered as an expert in this case, and we'll be  
10 dealing with that in the next few weeks. But,  
11 at the moment, we are entitled to know your  
12 opinions in your report, and so I'm trying to  
13 figure out here in your deposition what opinions  
14 you plan -- excuse me, what opinions you have at  
15 this moment. It should -- it -- it's not on us  
16 to -- to wait until trial to find out what those  
17 opinions are.

18 Are you able to point me in your  
19 report to what the opinions are that you  
20 anticipate offering at trial, as set out in your  
21 report?

22 A. Well, --

23 MR. KILARU: Objection. Asked and  
24 answered, and argumentative.

25 BY MR. NADING:



1           -- it may or may not be part of the litigation.  
2           I would have to review the pleadings to see if  
3           -- if that specific mark is also mentioned by  
4           itself in the -- in the complaint.

5           Q.    If you'll look at Paragraph 14 of your  
6           report.

7                    Do you have it?

8           A.    Yes.

9           Q.    How do you know what the examining  
10          attorney did?

11          A.    By reviewing the file and  
12          looking at the sheet of paper which indicates  
13          the -- the design sear -- the search history  
14          information -- the search the examining attorney  
15          conducted in this case.

16          Q.    Who was the examining attorney?

17          A.    I forget his name.

18          Q.    Do you know if it was the same  
19          examining attorney the entire time?

20          A.    My recollection is it was. I -- if it  
21          was not, I stand corrected.

22          Q.    Were you there with the examining  
23          attorney when he was doing what you describe in  
24          Paragraph 14?

25          A.    Of course not.

1 statements in Paragraph 14? Are you reading  
2 from the prosecution file history?

3 A. Yes. Of course. Reading  
4 through the -- the file history of applicant's  
5 application, you see what the examining attorney  
6 said and you can see what the examining attorney  
7 did.

8 Q. So do you have any independent basis  
9 for your statements in Paragraph 14 beyond  
10 reading from the prosecution file history here?

11 A. No. My statements are based upon  
12 the -- the prosecution history and applicant's  
13 application, that's correct.

14 Q. If you'd look at Paragraph 18 of your  
15 report, in the -- well, take a minute and tell  
16 me when you're ready.

17 A. Yes. I have it.

18 Q. The last sentence in -- in that  
19 Paragraph 18 of your report, my question is,  
20 what is the purpose of your statement that,  
21 quote, the examining attorney handling  
22 ARA's application did not cite any of those  
23 registrations for applications as confusingly  
24 similar to ARA's mark and allow ARA's mark to  
25 register?

1           A.    The purpose of that statement is just  
2           to inform the reader of my report that that  
3           happened; the examining attorney conducted a  
4           search, no registrations, including those that  
5           I listed, turned -- was -- were cited by the  
6           examining attorney.

7           Q.    Are you offering any independent  
8           -- excuse me, any expert testimony as regards  
9           what you characterize as a fact beyond what is  
10          ascertainable from the prosecution file history?

11          A.    You would have to rephrase that  
12          question.

13          Q.    Is that statement -- the last sentence  
14          of Paragraph 18, is that a legal opinion?

15          A.    No. I'm simply recite -- reciting  
16          the fact that the examining attorney didn't cite  
17          any registrations, including those listed in  
18          the Paragraph 17, as a -- a bar to appli --  
19          applicant's mark. In fact, no registrations  
20          were cited at all.

21          Q.    So what -- so what's the purpose of  
22          that statement, then, in Paragraph 18? Why  
23          -- why -- why make it?

24          A.    It's for the -- the reader of my  
25          report knowing that that's a fact. Just to

1 educate the reader that the examining attorney  
2 conducted a search, found no confusingly similar  
3 registrations. I mean, after all, this case at  
4 its heart is about likelihood of confusion of  
5 plaintiff's mark with the defendant's mark, and  
6 in -- indicating that the examining attorney did  
7 a search and found no confusingly similar  
8 registrations.

9 Q. And the defendant's mark is what?

10 A. The mark shown reproduced on Page 4 of  
11 my report. That's the applied-for mark. That's  
12 the mark that's before the Office.

13 Q. Understood. And -- and you understand  
14 we're here today on a case that's pending in  
15 U.S. District Court in the Western District of  
16 Virginia, Charlottesville?

17 A. Yes.

18 Q. In that same statement in Paragraph  
19 18, when you refer to, "Did not cite any of  
20 those registrations or applications," you're  
21 referring to the chart at Paragraph 17, I  
22 assume; is that correct?

23 A. Yes.

24 Q. And why those particular registrations  
25 or applications, to use your words?

1           A.    Well, because I'm listing those  
2           third-party registrations as out there, and that  
3           the fact that the examining attorney didn't cite  
4           any of them or -- or any other registration  
5           against the applicant's mark. It's a statement  
6           of fact.

7           Q.    If you look at Paragraph 19 of  
8           your report, the last sentence, or the second  
9           sentence, I guess, is, "In other words, under  
10          USPTO practice and procedure, multiple examining  
11          attorneys did not consider marks that differed  
12          by only one letter from the plaintiff's  
13          registered CFA marks to be conflicting or likely  
14          to cause confusion. Plaintiff also did not  
15          oppose any of the above applications."

16                   How do you know what the examining  
17          attorneys did?

18          A.    We know what an examining attorney  
19          did. We -- we don't know what an examining  
20          attorney was thinking. But, certainly, that's  
21          a -- a statement of fact, that the examining  
22          attorney -- in none of the third-party  
23          registrations was there any refusal on the basis  
24          of a prior existing application of registration.

25          Q.    And so similar to the questions I was

1 asking a few minutes ago, were you there with  
2 any of those examining attorneys when they were  
3 making their decisions and issuing their  
4 reports?

5 A. Of course not.

6 Q. So your report -- this statement in  
7 your report is based on your reading of the  
8 prosecution file history for records before the  
9 PTO?

10 A. My statement is a conclusion  
11 from reviewing the file histories of the  
12 third-party registrations, which are cited in  
13 Paragraph 17, that no examining attorney refused  
14 any of those registrations and -- well, --

15 Q. So did you --

16 A. -- I'll leave it at that.

17 Q. So, I mean, I -- similar que -- same  
18 question: Did you speak with each of those  
19 examining attorneys in connection with preparing  
20 your report?

21 A. Of course not.

22 Q. Have you met the examining attorneys?

23 A. We're talking about a number of  
24 examining attorneys, and I don't recall any  
25 of their names except, perhaps, I remember Dom

1 recall at all.

2 Q. Okay. And you're talk -- no  
3 opposition proceedings you mean?

4 A. That's correct. In -- in -- including  
5 one brought by plaintiff.

6 Q. In Paragraph 20 of your report you  
7 say, "The coexistence of these marks on the  
8 Federal Trademark Register also indicates that  
9 during prosecution of those registrations the  
10 USPTO did not find that any of these numerous  
11 registrations conflicted with one another in  
12 terms of a likelihood of confusion."

13 Same questions as we've been talking  
14 about. How do you know what the examining  
15 attorneys did?

16 A. We know from the file histories of,  
17 I think, all but four of them, where there are  
18 search strategies of records, what the examining  
19 attorneys searched, and that each of those  
20 applications, there was either a first  
21 action pub -- publication, or an office action  
22 indicating that a search was conducted and  
23 no confusingly similar mark was found.

24 Q. So your statement in Paragraph 20 is  
25 based on your review of the prosecution file

1           Q.    And in Paragraph 14, there's a  
2               statement, it's in the middle of Paragraph 14, I  
3               think it's the second sentence, which I'll read  
4               it. It says, "Because ARA's mark has a number  
5               of -- let me start over.

6               The quote is, "Because ARA's mark has  
7               a number of elements, open paren, the letters  
8               NAPA and CF -- and CPFA, the words Certified  
9               Plan Fiduciary Advisor, and design elements,  
10              that search strategy would be reasonable to  
11              retrieve all relevant previously registered and  
12              applied-for marks."

13             Do you -- do you see that statement in  
14             your report?

15            A.    Yes.

16            Q.    Is that -- is that statement based on  
17               your experience as an examining attorney insofar  
18               as your conclusion that the examining attorney's  
19               search was reasonable?

20            MR. NADING:  Objection.

21            THE WITNESS:  Yes.  I mean, I was an  
22               examining attorney, although it was a long time  
23               ago, for three or four years, and I've conducted  
24               numerous searches.  And in those days we didn't  
25               have electronic searches, but we did search,



1 by class, in the old paper files. And we -- I  
2 would have searched, in a similar method, the  
3 initialism or acronym, NAP -- NAPA, and the --  
4 the letters involved, CPFA, and the words, or  
5 truncated versions of the words, Certified Plan  
6 Fiduciary Adviser. And then the design element,  
7 you would have to, sort of, decide what it was  
8 and search that.

9 In view of the fact that all of those  
10 elements are in the mark, yes, I think the  
11 examining attorney's search of each of those  
12 elements in -- in the electronic system was  
13 -- was reasonable -- completely reasonable.

14 BY MR. KILARU:

15 Q. I want to turn to your earlier  
16 testimony in connection with Paragraph 22 of  
17 your report, if you could turn to that  
18 paragraph.

19 A. Yes.

20 Q. Now, I'll just -- for purposes of the  
21 record, I'll just read the -- the -- the first  
22 sentence of that, which says, "Here, if  
23 plaintiff believed that the identification of  
24 services for any of the above registrations was  
25 broader than the services for which the mark was

1 the counterclaim in this case or is that a -- is  
2 that an independent fact on its own, the fact  
3 that they did not file any restrictions actions  
4 against any of these registrations, and -- and,  
5 therefore, did not believe, presumably, that any  
6 of those marks were confusingly similar?

7 MR. NADING: Objection. Move to  
8 strike the question.

9 The -- Mr. Kilaru, you're testifying,  
10 not asking questions.

11 MR. KILARU: It's a fair question.

12 MR. NADING: No, it's not. That's  
13 entirely inappropriate. We've noted our  
14 objection.

15 THE WITNESS: Certainly, the -- the  
16 Section 18 comments in my report were prompted  
17 by the counterclaim. But, certainly, they  
18 -- they can stand on their own, because, I mean,  
19 it's a -- it's a true statement that the  
20 plaintiff not only, apparently, did not seek to  
21 cancel the registrations, but didn't file any  
22 Section 18 restriction. If the plaintiff  
23 thought that those marks were similar and the --  
24 the descriptions of goods or services was too  
25 broad and needed to be restricted to avoid

1           likelihood of confusion, that kind of action is  
2           available to a plaintiff.

3           BY MR. KILARU:

4           Q.    I'd like to ask you to turn to  
5           Paragraph 25.

6           A.    Yes.

7           Q.    Now, you test -- and I'm referring  
8           to Page 75 of the realtime transcript, and you  
9           -- you testified, as -- as I -- as I'm reading  
10          from the realtime transcript in connection with  
11          Page 25, I didn't mean to -- so the question  
12          was, "Are you adding anything additional in  
13          Paragraph 25, other than reading the pleadings?"  
14          And your answer was, "I didn't mean to add  
15          anything in addition. I think I summarized the  
16          registrations listed."

17          Now, I want to turn your attention to  
18          the penultimate sentence in Paragraph 25, which  
19          reads, "Plaintiff's apparent position that even  
20          a one-letter difference between the marks can be  
21          sufficient to distinguish them is, apparently,  
22          consistent with the USPTO position noted above."

23          Is that -- is -- that opinion, as  
24          you've stated it there, is that based on your  
25          experience as a former Trademark Trial and

1 Appeal Board Judge, as well as your experience  
2 as a former trademark examining attorney?

3 MR. NADING: Objection. The witness  
4 offered no opinions.

5 MR. KILARU: Well, the doc -- the  
6 document speaks for itself. Well, let --

7 MR. NADING: It sure does.

8 BY MR. KILARU:

9 Q. Let me ask you, Mr. Simms, that  
10 statement that I've just read, "Plaintiff's  
11 apparent position that even a one-letter  
12 difference between marks can be sufficient to  
13 distinguish them, is apparently consistent with  
14 the USPTO position noted above," is that -- is  
15 that your opinion?

16 A. Yes. I mean, it -- it is correct,  
17 from a review of what the plaintiff has stated  
18 and what the office has done, that those  
19 differences did lead to the results that we have  
20 seen, that no examining attorney cited any  
21 registrations -- when he or she examined the  
22 third-party registrations listed, didn't cite  
23 any marks that differed by one letter from any  
24 of -- of those applied-for marks. And -- and  
25 here we have the plaintiff making comments in

1 his response to applicant's motion for summary  
2 judgment that var -- various listed marks, which  
3 did differ by letters, were easily  
4 distinguishable from its mark based upon the  
5 marks and/or goods and services.

6 So the statement is based on the marks  
7 and/or goods and services, so I think it's a  
8 fair statement to make that that appears to be  
9 the apparent position of the Office and the  
10 -- and the plaintiff.

11 MR. KILARU: Thank you.

12 Subject to any further questions from  
13 Mr. Nading, I don't have any other questions.

14 MR. NADING: So I do have some  
15 follow-up questions here.

16 FURTHER EXAMINATION

17 BY MR. NADING:

18 Q. Mr. Simms, when were you an examining  
19 attorney?

20 A. 1972 to 1975 or 6. I hope I have the  
21 years right.

22 Q. Your -- your resume, Exhibit 1 to your  
23 report, says '72 to '75. Does that sound right?

24 A. That sounds right.

25 Q. And you graduated from -- or you got

1 motion that was filed in a matter between the  
2 parties to this case?

3 A. Yes. I know it was not. It was filed  
4 between plaintiff and the -- the entity that  
5 owns the CDFA mark.

6 Q. And you know that based on reading the  
7 pleadings; is that correct?

8 A. The pleadings?

9 Q. How do you know that?

10 A. Because I reviewed that document, and  
11 it was not between plaintiff and the -- the ARA  
12 or any of the defendants in this case. It was  
13 between plaintiff and the entity that owns the  
14 CDFA mark, which I believe is one of the marks  
15 listed in the Paragraph 17.

16 Q. Looking at the penultimate sentence in  
17 Paragraph 25, "Plaintiff's apparent position  
18 that even a one-letter difference between marks  
19 can be sufficient to distinguish them is  
20 apparently consistent with the USPTO position  
21 noted above," we talked about this at length  
22 earlier, as well, when I was asking you  
23 questions, what is your basis for -- for  
24 commenting on plaintiff's apparent position?

25 A. The fact that plaintiff, for example,

1           stated that those marks listed earlier in  
2           Paragraph 25 were easily distinguishable from  
3           its mark based upon the marks and/or the goods  
4           and services. It's a statement from plaintiff  
5           saying that those marks listed were easily  
6           distinguishable based upon the marks and/or  
7           goods and services.

8           Q.    So are you purporting to testify as to  
9           what plaintiff's position is?

10          A.    That's not my intention. My intention  
11          is just to summar -- my summary of what has  
12          happened in this case, including some -- my  
13          summation of what happened as a result of  
14          plaintiff's statements; that those marks were  
15          easy -- easily distinguishable.

16          Q.    What is --

17          A.    And --

18          Q.    What is your basis -- I'm sorry. I  
19          didn't mean to cut you off.

20          A.    Well, that's why I said "apparent  
21          position." We don't know what's in plaintiff's  
22          mind. So, apparently, they were taking the  
23          position that those marks were easily  
24          distinguishable. And why were they  
25          distinguishable? They all seemed -- they're

1 not identical, but they all differ by one or  
2 more letters from plaintiff's mark.

3 Q. So is it fair to say that you're  
4 speculating about plaintiff's position?

5 A. I'll let the words speak for  
6 themselves.

7 Q. Does the word opinion appear in your  
8 report?

9 A. I don't know if it does or not.

10 MR. NADING: I don't have any further  
11 questions, subject to Mr. Kilaru.

12 MR. KILARU: No. No other questions  
13 here. Thank you.

14 MR. NADING: Thank you, Mr. Simms.

15 THE WITNESS: You're welcome.

16 THE VIDEOGRAPHER: We're going to go  
17 off the video record. The time is 12:55 p.m.,  
18 and this concludes today's testimony given by  
19 Rany Simms. The total number of media disks was  
20 two and will be retained by Veritext Legal  
21 Solutions.

22 (Deposition concluded -- 12:55 p.m.)  
23  
24  
25





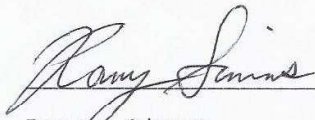
1 CFA Institute v. American Society Of Pension


Professionals & Actuaries Et Al

2 Rany Simms (#4080639)

3 ACKNOWLEDGEMENT OF DEPONENT

4 I, Rany Simms, do hereby declare that I  
5 have read the foregoing transcript, I have made any  
6 corrections, additions, or changes I deemed necessary as  
7 noted above to be appended hereto, and that the same is  
8 a true, correct and complete transcript of the testimony  
9 given by me.

10   
11 \_\_\_\_\_  
12 Rany Simms

  
Date

13 \*If notary is required

14 SUBSCRIBED AND SWORN TO BEFORE ME THIS

15 \_\_\_\_\_ DAY OF \_\_\_\_\_, 20\_\_\_\_.

16 \_\_\_\_\_  
17  
18  
19 NOTARY PUBLIC  
20  
21  
22  
23  
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25